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EXAMINER
LE, HIEU C

ART UNIT	PAPER NUMBER
2142	20

DATE MAILED: 01/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No. 09/634,691	Applicant(s) FLEMING, HOYT A.
Office Action Summary	Examiner Hieu c. Le	Art Unit 2142

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE __3__ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☒ This action is **FINAL.**   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-6,8-14,16,17 and 20-23* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-6,8-14,16,17 and 20-23* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a) ☐ All b) ☐ Some * c) ☐ None of:

   1. ☐ Certified copies of the priority documents have been received.
   2. ☐ Certified copies of the priority documents have been received in Application No. _____.
   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

   a) ☐ The translation of the foreign language provisional application has been received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1.   The affidivit filed on 10/6/03 under 37 CFR 1.131 is sufficient to overcome the

Birrell et al. reference.

2.   The Applicant 's argument filed 10/06/03 have been fully considered but they are

not persuasive for the following reasons:

Applicant alleges that " the Hall reference teaches [,]" (p. 8, line 19- p. 9, lines

24). The Examiner disagrees. Firstly, the rejection of the claims is based on three

references not only Hall, references can not be argued individually to show nonobvious

(see MPEP. 2145 (d)). Secondly, Hall discloses that the messages from the authorized

users are rejected, i.e the unwanted messages are received and checked and rejected

(i.e. available to the system). Third, Gross discloses filtering incoming e-mail to sort it

into different folders with Junk mail being sorted to a trash folder (col. 17, lines 73-79).

Applicant alleges that " the undersigned submits that to the contrary [,]" (p. 10,

line 7- p. 11, line 18). In response to applicant's argument that the references are not

properly combinable, the test for obviousness is not whether the features of a

secondary reference may be bodily incorporated into the structure of the primary

reference; nor is it that the claimed invention must be expressly suggested in any one or

all of the references. Rather, the test is what the combined teachings of the references

would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d

413, 208 USPQ 871 (CCPA 1981).

Claim Rejections - 35 U.S.C. § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set

forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 1-6, 8, 11-14, 16, 20-23 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Hall [US. Pat. No. 5,930,479] in view of Gross et al. [US. Pat. No.

5,283,856] and further in view of " Specifying filter criteria" Nov 14,1995.

As to claim 1, Hall discloses a method in a computer system for filtering

unauthorized electronic mail messages that are sent by senders to a user, each sender

having an identification each electronic mail message including the identification of the

sender (col. 8, lines 48-53, col. 10, line 30-33), the method comprising:

providing a list of the identifications of the senders who are authorized to send an

electronic mail message to the user [a user channel database (list) that records a

channel ID and address of the correspondent (col. 10, lines 26-42)];

for each of a plurality of electronic mail messages (fig. 2, items 208a, 210a),

determining whether the sender of the electronic mail message is authorized by

determining whether the identification of sender in the electronic mail message is in the

provided list of the identifications of the senders who are authorized [send mail lookup

user's name in the system password file (a standard database defining the valid users

of the system, and separates the address into name and channel ID, and matches the

channel ID of the incoming message with one of the lines in the channels file 212 (col.

11, lines 40-49) for verify that the message is authorized for delivery to the recipient (Abstract, lines 7-8)];

Hall does not disclose,

when the sender of the electronic mail message is determined to be not authorized, storing the electronic mail message in a second folder designated for electronic mail messages received from unauthorized senders; and

when the sender of the electronic mail message is determined to be authorized, storing the electronic mail message in a first folder designated for electronic mail messages received from authorized senders.

whereby the electronic mail messages are automatically stored in the appropriate folder based on whether the sender is authorized so that the user can view the first folder containing the electronic mail messages sent by authorized senders separately from the second folder containing the electronic mail messages sent by unauthorized senders.

Gross discloses a conditional rule based system which can be transparently implemented for mapping specific mail messages (col. 2, lines 40-54). If- then sequences are automatically used to process or "filter" messages in many folders .New/messages are filtered in different folders with Junk mail "unauthorized messages" in the trash folder and other new messages in other folders (col. 17, lines 73-79).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Gross's teachings to modify Hall's method by using an "If-then" filter to filter new incoming mail in different folders with junk mail "unauthorized mail" in a trash folder in order to provide a flexible, efficient system which can be implemented transparently to filter electronic -mail.

Neither Hall nor Gross disclose the second folder being optionally viewable by the user.

" Specifying filter criteria" discloses filters that filter procmail which is very powerfull & not very difficult to use. User would like all messages from a certain person to go into a separate mail folder called filtered in mail direction for later review in order not losing important mail (page. 1, lines 4-7).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Specifying filter 's teachings to the method of Hall and Gross by storing the mail message into a folder (in UNIX environment) for optionally viewable by user to indicate that the message is from authorized sender (Inbox i.e ^From.ower-emtex, lines 4-7) or unauthorized sender (unread, #example 2. lines 20-25) in order to facilitate mail handing, particularly for some one receiving a large amount of e-mail and reduce the amount of junk e-mail he receives and not losing important mail but still procmail's filter.

As to claim 2, Hall further discloses wherein when the user sends an electronic mail message to a recipient, the identification of the recipient is automatically added to the provided list of the identifications of senders who are authorized to send electronic mail message to the user (col. 12, lines 57-61).

As to claim 3, Hall further discloses wherein the provided list of the identifications of the senders is generated by adding the identification of senders of previously received electronic mail messages (col. 21, lines 56-63).

As to claim 4, Hall further discloses wherein the provided list of the identifications of the senders is generated by adding the identification of recipients of previously sent electronic mail messages (col. 17, lines 26-30).

As to claim 5, Hall discloses a method in a computer system for filtering unauthorized messages, each message having a sender, the method comprising:

for each of a plurality of messages (Fig. 2, items 208a, 210a),

determining whether the sender of the message is designated as being authorized [send mail lookup user's name in the system password file (a standard database defining the valid users of the system), and separates the address into name and channel ID, and matches the channel ID of the incoming message with one of the lines in the channels file 212 (col. 11, lines 40-49) for verify that the message is authorized for delivery to the recipient (Abstract, lines 7-8)];

when the sender of the message is determined to be authorized, indicating that the message is from an authorized sender (col. 11, lines 48-50 and col. 12, lines 6-25).

Hall does not disclose,

when the sender of the message is determined to be not authorized,

storing the message in a predesignated location for messages sent by unauthorized senders.

Gross discloses a conditional rule based system which can be transparently implemented for mapping specific mail messages (col. 2, lines 40-54). If- then sequences are automatically used to process or "filter" messages in many folders .New/messages are filtered in different folders with Junk mail "unauthorized messages" in the trash folder and other new messages in other folders (col. 17, lines 73-79).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Gross's teachings to modify Hall's method by using an "If-then" filter to filter new incoming mail in different folders with junk mail "unauthorized mail" in a trash folder in order to provide a flexible, efficient system which can be implemented transparently to filter electronic mail.

Neither Hall nor Gross disclose the predesgnated location being accessible by a mail recipient so that messages determined not to be authorized are optionally viewable by the mail recipient.

" Specifying filter criteria" discloses filters that filter procmail which is very powerfull & not very difficult to use. User would like all messages from a certain person to go into a separate mail folder called filtered in mail direction for later review in order not losing important mail (page. 1, lines 4-7).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Specifying filter 's teachings to the method of Hall and Gross by storing the mail message into a folder (in UNIX environment) for optionally viewable by user to indicate that the message is from authorized sender (Inbox i.e ^From.ower-emtex) or unauthorized sender (unread, #example 2. lines 20-25) in order to facilitate mail handing, particularly for some one receiving a large amount of e-mail and reduce the amount of junk e-mail he receives and not losing important mail but still procmail's filter.

As to claim 6, Hall further discloses wherein the recipient of the messages can identify whether a message is authorized based solely on the indications [the message is either accepted or rejected (col. 11, lines 48-52)].

As to claim 8, Hall further discloses wherein the message is an electronic mail message and the pre-designated location is a folder [the message is an e-mail message (col. 5, line 8) and the authorized message is discarded (i.e. stored in a deleted file) (col. 22, lines 15-19)].

As to claim 11, Hall further discloses wherein the computer system includes a list of authorized senders (col. 10, lines 26-42 & Fig. 4) and wherein the determining whether the sender of the message is designated as being authorized includes

determining whether the sender is in the list of authorized senders (col. 11, lines 40-49, col. 21, lines 56-63).

As to claim 12, Hall further discloses wherein the list of authorized senders is generated by adding the senders of the previously received messages to the list (col. 21, lines 56-63).

As to claim 13, Hall further discloses wherein the list of authorized senders is generated by adding the recipients of the previously sent messages to the list (col. 17, lines 26-30).

As to claim 14, Hall further discloses wherein the list is shared by multiple users (col. 9, lines 44-47, Fig. 2).

As to claim 16, Hall further discloses wherein when the recipient sends a message to an intended recipient, the intended recipient is added to the list as an authorized sender (col.12, lines 57-61).

As to claim 20, refer to claim 1 rejection.

As to claim 21, refer to claim 2 rejection.

As to claim 22, refer to claim 3 rejection.

As to claim 23, Hall uses a filter to reject unauthorized messages by discarding (i.e. forwarding the message to a delete folder) (col. 22, lines 15-19).

Hall does not explicitly disclose that the folder is labeled Junk mail. However, it is obvious to label a folder that is labeled discard and contains filtered e-mail from unauthorized sender and is used in the context of filtering Junk mail.

5.   Claims 9-10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hall [US. Pat. No. 5,930,479] in view of Gross et al [US. Pat. No. 5,283,856] in view of

"Specifying filter criteria" Nov 14,1995 , as applied to claim 5 and further in view of

Microsoft Corporation, "Excerpts from online documentation of Microsoft Exchange",

version 5.0.1458.47, 1986-1997, 11pp.

As to claims 9-10, neither Hall nor Gross nor "Specifying filter criteria" discloses

the limitation including when displaying a list of messages, displaying a visual indication

as to whether the message has been indicated as being sent from an authorized or

unauthorized sender, wherein the visual indication is the dimming of the messages that

are sent from unauthorized senders in the list of messages.

Microsoft Corporation discloses a visual indication method used in e-mail

message to dim profile message (page 8).

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to use Microsoft's teaching to modify the combined method of Hall,

Gross and "Specifying filter criteria" by using a visual displaying and dimming the junk

mail messages in the list of messages in order to indicate to the user that these

messages are irrelevant to his interest and save him valuable hours to be wasted in

dealing with junk mail.

6.   Claims 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hall

[US. Pat. No. 5,930,479] in view of Gross et al [US. Pat. No. 5,283,856] in view of

"Specifying filter criteria" Nov 14,1995, as applied to claim 5 and further in view of

Canale et al. [US. Pat. No. 5,619,648].

As to claim 17, neither Hall nor Gross nor "How to use the Net Access unsolicited

email filter" discloses wherein the indicating that the message is from an unauthorized

sender includes forwarding the message from an unauthorized to another user.

Canale discloses a method for reducing the amount of junk e-mail received by a

user of an e-mail system. The mail filter for potential recipient has access to a list of the

e-mail messages sent and received by the potential recipient and used the list of e-mail

messages to determine correspondents of the potential recipient and forwards the

messages to those recipients (col. 2, lines 27-44). The system permits the recipient of

the e-mail to select which of the correspondents (another users) is to receive the e-mail

(col. 4, lines 2-8).

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to use Canale's teaching to modify the combined method of Hall,

Gross, & "Specifying filter criteria" in order to facilitate mail handling, particularly for

some one receiving a large amount of e-mail and reduce the amount of junk e-mail he

receives.

7.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

8.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Hieu Le whose telephone number is (703) 306-3101. The examiner can normally be reached on Monday to Friday from 8:00 A.M.to 4:00 P.M. The fax number of this Group 2142 is (703)872-9306 or 308-9051 .

        Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

JACK B. HARVEY
SUPERVISORY PATENT EXAMINER